

PATENT

Paper No.

File: Skuba-P1-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor	:	SKUBA, Jerome
Serial No.	:	10/730,325
Filed	:	8 December 2003
For	:	IMPROVED METHOD OF PROPAGATION AND PRODUCT PRODUCED THEREBY
Group Art Unit	:	3644
Examiner	:	PALO, Francis

MS: Appeal
Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 2231301459

CORRECTED APPEAL BRIEF IN REINSTATED APPEAL

S I R :

Pursuant to the provisions set forth in MPEP 1204.01, Applicant reinstates the appeal. Accordingly, this Appeal Brief is in response to the Final Rejection by the Examiner dated 11/14/08, finally rejecting at least claims 1-21. Claims 22-24, pending in this application, have been acknowledged in the Final Rejection and have not been rejected; this appeal is occasioned because claims have been twice rejected.

The Office Action dated 12/12/07 reopening prosecution does not show the approval by the Supervising Primary Examiner as required by MPEP Sec. 1207.04. Regardless of whether the Examiner improperly reopened prosecution, Applicant is reinstating the appeal as provided by MPEP Sec. 1204.01.

The fees due for the Notice of Appeal and the Appeal Brief paid in the previous appeal

are to be applied to the reinstated appeal because the Board did not issue a final decision in the previous appeal. Any difference in the fees paid and the fees presently in force should be charged to Deposit Account No. 50-0235, along with any fee for any Extension of Time for filing of this appeal and Brief or for further prosecution. A Request for Oral Hearing will be filed in response to the Examiner's Answer.

I. **Real Party In Interest**

The real party in interest is the inventor, Jerome Skuba.

II. **Related Appeals and Interferences**

Appeals in each of the predecessor applications resulted in patents without any decision by the Board (See U.S. Patent Nos. 6,336,291 and 6,658,790), and there are no related appeals or interferences believed to be related.

III. **Status of Claims**

Claims 1-21 have been rejected under "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." Claims 22-24 have not been rejected or allowed.

IV. **Status of Amendments Filed Subsequent to Final Rejection**

No Amendments have been filed since the Final Rejection was issued.

V. **Summary of the Claimed Subject Matter**

The claimed subject matter is believed to be summarized well in claim 1, which is as follows: A method of forming a garden, the method including: forming a design for a garden; implementing the design by forming a piece corresponding to a portion of the design, the piece including at least one member of the group consisting of forbs, a shrub, a tree, annuals, flowering plants, a bush, wildflowers, grasses, a space for a shrub, a space for a tree, a space

for annuals, a space for layers of flowering plants, a space for a bush, a space for wildflowers, a space for grasses, a space for a walkway, and a space for a garden accouterment, by growing roots in the piece at at least one grower location; transporting the piece to a user's garden location; and installing the piece, so that the roots can knit essentially unimpeded from the piece into earth below the piece at the user's garden location, in accordance with the design.

It is also believed that the claimed subject matter as to claim 21 is best summarized by the claim itself: A method of forming a corporate logo garden, the method including: forming a design for a garden comprised of a corporate logo; growing the corporate logo, in accordance with the design, including at least one member of the group consisting of a forb, a shrub, a tree, an annual, a flowering plant, a bush, a wildflower, and grass, at a grower location; transporting the corporate logo to a garden site; and installing the corporate logo at the garden site to produce the garden having the corporate logo design.

More particularly, please see the chart below:

Claims

Representative Support

1. A method of forming a garden, the method including:

forming a design for a garden;

implementing the design by forming a piece corresponding to a portion of the design, the piece including at least one member of the group consisting of forbs, a shrub, a tree, annuals, flowering plants, a bush, wildflowers, grasses, a space for a shrub, a space for a tree, a space for annuals, a space for layers of flowering plants, a space for a bush, a space for wildflowers, a space for grasses, a space for a walkway, and a space for a garden accouterment, by growing roots in the piece at at least one grower location;

transporting the piece to a user's garden location; and

installing the piece, so that the roots can knit essentially unimpeded from the piece into earth below the piece at the user's garden location, in accordance with the design.

FIG. 6 is an illustration of a design...

...commercially producing a garden

design... Pg. 8, para 4 Lns. 11-12

...combination of the articles, that is,

including a second article...forbs, grass, at least one shrub, at least one tree,

perennials, annuals, or any combination

thereof--even with spacing for such garden

accouterments as a walkway, water garden,

bird bath, fountain, furniture, or other

commonly encountered garden apparatus

or manufacture. Page 10, para 1, Ins. 6-18

...transporting the design from a grower to a user's site... Page 8, para 4, line 13

2. A method of forming a garden,

the method including:

forming a design for a garden;

forming pieces corresponding to portions of the design by growing mats of roots of respectively different kinds of plants, in accordance with the design, at at least one grower location;

harvesting the mats;

transporting the mats to a user's garden location; and

installing the mats at the user's garden location so that the roots are able to knit essentially unimpeded from the mats into earth below the mats to form the garden, according to the design.

commercially producing a garden design...

Pg. 8, para 4 Lns. 11-12

propagating wild flowers in sod mats... such that roots of seedlings from said seeds intermesh with the fabric forming a sod mat;

Page 9, para. 2, lns. 9-13;

...for easier propagation and harvesting purposes. Page 18, para. 2, ln. 13;

...wherein the composition...do not fall apart during... transporting, Page 6, para. 5, ln. 17; ... transporting the design from a grower to a user's site, Page 6, para. 5, ln. 17; ... plant crowns and roots are allowed to knit with the earth... Page 9, line 5.

3. The method of claim 2, wherein the design is implemented with at least one of the pieces including at least one member of the group consisting of forbs, a shrub, a tree, annuals, flowering plants, a bush, wildflowers, grasses, a crop, a space for a shrub, a space for a tree, a space for annuals, a space for flowering plants, a space for a bush, a space for wildflowers, a space for grasses, a space for a walkway, and a space for a garden accouterment, in accordance with the design.

4. The method of claim 3, further including a second member of the group, in accordance with the design.

5. The method of claim 3, further including a third member of the group, in accordance with the design.

...including a second article...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof--even with spacing for such garden accouterments as a walkway, water garden, bird bath, fountain, furniture, or other commonly encountered garden apparatus or manufacture. Page 10, para 2, Ins. 8-18

...there is a combination of the articles, that is, including a second article, ... Page 10, para. 2, Ins. 7-8.

... there is a combination of the articles, ...: a top net; a bottom net made of a material that is pervious to moisture; a mat intermediate the top net and the bottom net; a three-dimensional net intermediate the top net and the mat...Page 10, para. 2, Ins 7-10

6. The method of claim 3, wherein the mats differ by at least one kind of plant that is a member of the group, in accordance with the design.

7. The method of claim 3, wherein the mats differ by at least two kinds of plants that are members of the group, in accordance with the design.

8. The method of claim 3, wherein the mats differ by at least three kinds of plants that are members of the group, in accordance with the design.

9. The method of claim 3, wherein the mats differ by at least four kinds of plants that are members of the group, in accordance with the design.

...wherein the articles are installed adjacent each other and include a different kind of plants. Page 10, para. 2, Ins. 13-14

...wherein the plant roots include roots of prairie wildflowers ...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof...Page 10, para. 2, Ins. 15-17.

...wherein the plant roots include roots of prairie wildflowers ...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof...Page 10, para. 2, Ins. 15-17.

...wherein the plant roots include roots of prairie wildflowers ...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof...Page 10, para. 2, Ins. 15-17.

10. The method of claim 3, wherein the mats differ by at least five kinds of plants that are members of the group, in accordance with the design.

11. The method of claim 3, wherein the mats differ by at least six kinds of plants that are members of the group, in accordance with the design.

12. The method of claim 3, wherein the mats differ by at least seven kinds of plants that are members of the group, in accordance with the design.

13. The method of claim 3, wherein the mats differ by at least eight kinds of plants that are members of the group, in accordance with the design.

14. The method of claim 6, further including lawn on a portion of at least one of the mats.

...wherein the plant roots include roots of prairie wildflowers ...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof...Page 10, para. 2, Ins. 15-17.

...wherein the plant roots include roots of prairie wildflowers ...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof...Page 10, para. 2, Ins. 15-17.

...wherein the plant roots include roots of prairie wildflowers ...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof...Page 10, para. 2, Ins. 15-17.

...wherein the plant roots include roots of prairie wildflowers ...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof...Page 10, para. 2, Ins. 15-17.

...a formal garden, complete with a lawn ...
Page 19, para. 2, ln. 8

15. The method of claim 7, further including lawn on a portion of at least one of the mats.

...a formal garden, complete with a lawn...Page 19, para. 2, ln. 8

16. The method of claim 2, wherein the forming the design includes forming a design of a corporate logo.

...garden design, such as, a corporate logo... Page 8, para. 4, lns 11-12;
...here represented by a corporate logo...Page 11, para. 6, ln 12;
...create a seed pattern to construct a design such as a corporate logo...Page 20, para. 2, ln. 3

17. The method of claim 1, wherein the forming the design includes forming a design of a corporate logo.

...garden design, such as, a corporate logo... Page 8, para. 4, lns 11-12;
...here represented by a corporate logo...Page 11, para. 6, ln 12;
...create a seed pattern to construct a design such as a corporate logo...Page 20, para. 2, ln. 3;

18. The method of claim 1, wherein the forming the piece is carried out so as to include a second member of the group, in accordance with the design.

...there is a combination of the articles, that is, including a second article, ... Page 10, para. 2, Ins. 7-8.

19. The method of claim 1, wherein the forming the piece is carried out so as to include a third member of the group, in accordance with the design.

...
... wherein the plant roots include roots of prairie wildflowers...forbs, grass, at least one shrub, at least one tree, perennials, annuals, or any combination thereof...Page 10, para. 2, Ins. 15-17

20. The method of claim 1, further including forming a second piece corresponding to a second portion of the design, the second piece differing from the first piece by at least one kind of plant that is a member of the group, in accordance with the design;

growing the second piece, in accordance with the design;

transporting the second piece to the user's garden location; and

installing the second piece at the user's garden location, in accordance with the design.

a combination of the articles, that is, including a second article, the second including...wherein the articles are installed adjacent each other and include a different kind of plants...Page 10, para. 2, lns. 7-14

there is a combination...including a second article, the second... including...a growing medium...plant roots in the growing medium; and wherein the bottom net is sufficiently pervious to permit...root contact with earth below the bottom net...Page 10, para. 2, lns. 7-13;

Such articles can be ...transported to a site of installation...Page 10, para. 2, lns. 14-15
Page 10, para. 3, lns. 14-15

an entire garden can be ... installed according to plan at a user's location...Page 19, para. 2, lns. 16-18

21. A method of forming a corporate logo garden, the method including:

forming a design for a garden comprised of a corporate logo;

growing the corporate logo, in accordance with the design, including at least one member of the group consisting of a forb, a shrub, a tree, an annual, a flowering plant, a bush, a wildflower, and grass, at a grower location;

transporting the corporate logo to a garden site; and

installing the corporate logo at the garden site to produce the garden having the corporate logo design.

22. The method of claim 1, wherein the forming comprises locating a biodegradable matrix within the piece.

23. The method of claim 2, wherein the growing comprises locating a biodegradable matrix within the piece.

...garden design, such as, a corporate logo... Page 8, para. 4, lns 11-12;

...here represented by a corporate logo...Page 11, para. 6, ln 12;

...create a seed pattern to construct a design such as a corporate logo...Page 20, para. 2, ln. 3

...transporting, and then timely installing the logo on site in one quick and convenient installation...Page 20, para. 1, lns. 5-6

...composition and article of manufacture include at least one biodegradable base sheet...Page 7, para. 1, ln. 3

... formed on a sheet of a porous, preferably biodegradable... material;

Page 8, para. 7, Ins. 21-22;

...is formed on a sheet of a porous,
preferably biodegradable textile
material...Page 9, para.2, ln. 15;

24. The method of claim 3, wherein the
growing comprises growing the corporate logo
in a biodegradable matrix.

...bottom net...can be biodegradable, which
facilitates making...structure 2 as
including...one moisture-permeable bottom
net...preferably reasonably biodegradable.
Page 13, para. 3, Ins. 12-14; ...as made
completely of biodegradable plastic
material...Page 13, para. 3, Ins. 16-17.

VI. Grouping of Claims for Each Ground of Rejection Which Appellant Contests

The claims are grouped as set forth below for the rejections made pursuant to Sec. 102:

- Group I. Claims 1, 18-20
- Group II. Claim 17
- Group III. Claims 2-15
- Group IV. Claim 16
- Group V. Claim 21
- Group VI. Claim 22
- Group VII. Claim 23
- Group VIII. Claim 24

The claims rejected pursuant to Sec. 103 are not grouped and are separately argued.

A. § 102

1. Has the Examiner made a prima facie showing that claim of Group I are unpatentable pursuant to 35 U.S.C. § 102 based on JP 10313690A (Kawamoto)?
2. Has the Examiner made a prima facie showing that claim of Group II are unpatentable pursuant to 35 U.S.C. § 102 based on JP 10313690A (Kawamoto)?
3. Has the Examiner made a prima facie showing that claim of Group III are unpatentable pursuant to 35 U.S.C. § 102 based on JP 10313690A (Kawamoto)?
4. Has the Examiner made a prima facie showing that claim of Group IV is unpatentable pursuant to 35 U.S.C. § 102 based on JP 10313690A (Kawamoto)?
5. Has the Examiner made a prima facie showing that claim of Group V is unpatentable pursuant to 35 U.S.C. § 102 based on JP 10313690A (Kawamoto)?
6. Has the Examiner made a prima facie showing that claim of Group VI is

unpatentable pursuant to 35 U.S.C. § 102 based on JP 10313690A (Kawamoto)?

7. Has the Examiner made a prima facie showing that claim of Group VII is unpatentable pursuant to 35 U.S.C. § 102 based on JP 10313690A (Kawamoto)?

8. Has the Examiner made a prima facie showing that claim of Group VIII is unpatentable pursuant to 35 U.S.C. § 102 based on JP 10313690A (Kawamoto)?

The Examiner appears to have examined and considered claims 22-24 as noted in the Final Rejection of 11/14/08 at page 4. These claims are not listed on the Office Action Summary page, so the Examiner either made an error on the Summary page or neglected to indicate whether the claims are allowed or rejected. However, clearly appeal guidance is needed where the Examiner rejects claims pursuant to Sec. 102, concedes that cited art devices "are incapable" of meeting the claim requirements, and after an appeal, reopens prosecution and maintains the rejection. Thus, to advance prosecution with appellate guidance, the claims that the Examiner apparently neglected to examine are set forth herein to ensure that they are not altogether omitted from the application. As these are dependent claims, a reversal of the rejection of the independent claims would be equally applicable to a reversal on the dependent claims.

B. § 103

1. Has the Examiner made a prima facie showing that claim 1 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

2. Has the Examiner made a prima facie showing that claim 2 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

3. Has the Examiner made a prima facie showing that claim 3 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

4. Has the Examiner made a prima facie showing that claim 4 is

unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

5. Has the Examiner made a prima facie showing that claim 5 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

6. Has the Examiner made a prima facie showing that claim 6 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

7. Has the Examiner made a prima facie showing that claim 7 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

8. Has the Examiner made a prima facie showing that claim 8 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

9. Has the Examiner made a prima facie showing that claim 9 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

10. Has the Examiner made a prima facie showing that claim 10 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

11. Has the Examiner made a prima facie showing that claim 11 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

12. Has the Examiner made a prima facie showing that claim 12 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

13. Has the Examiner made a prima facie showing that claim 13 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

14. Has the Examiner made a prima facie showing that claim 14 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

15. Has the Examiner made a prima facie showing that claim 15 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

16. Has the Examiner made a prima facie showing that claim 16 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

17. Has the Examiner made a prima facie showing that claim 17 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

18. Has the Examiner made a prima facie showing that claim 18 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

19. Has the Examiner made a prima facie showing that claim 19 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

20. Has the Examiner made a prima facie showing that claim 20 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

21. Has the Examiner made a prima facie showing that claim 21 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

22. Has the Examiner made a prima facie showing that claim 22 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

23. Has the Examiner made a prima facie showing that claim 23 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

24. Has the Examiner made a prima facie showing that claim 24 is unpatentable pursuant to 35 U.S.C. § 103 based on JP 10313690A (Kawamoto)?

As stated above, the Examiner appears to have examined and considered claims 22-24 as noted in the Final Rejection of 11/14/08 at page 4. These claims are not listed on the Office Action Summary page, so the Examiner either made an error on the Summary page or neglected to indicate whether the claims are allowed or rejected. However, clearly appeal guidance is needed where the Examiner rejects claims pursuant to Sec. 102, concedes that cited

art devices "are incapable" of meeting the claim requirements, and after an appeal, reopens prosecution and maintains the rejection. Thus, to advance prosecution with appellate guidance, the claims that the Examiner apparently neglected to examine are set forth herein to ensure that they are not altogether omitted from the application. As these are dependent claims, a reversal of the rejection of the independent claims would be equally applicable to a reversal on the dependent claims.

VII. Argument

A. Overview

This appeal involves 35 U.S.C. Sec. 102, the basis for the rejection of each of claims 1-21 in the Final Rejection.

In the Final Rejection, the Examiner contends that each of claims 1-21 is anticipated by Kawamoto.

In a nutshell, as discussed in greater detail below, Applicant's claims 1-20 are directed to mats or pieces applied directly to the earth. The cited art (Kawamoto) is directed to container gardening "on a rooftop and balcony of a building or inside lot." Thus, the cited art is not the same as the claimed subject matter, especially as to whether the roots can knit essentially unimpeded... into the earth below.

The Office Action of 03/08/07 (Page 6) concedes that "the manufactured multiple standardized units of Kawamoto are incapable of knitting with the earth below due to their containment means". As pointed out in Applicant's pre-appeal brief review request, there cannot be anticipation where the prior art device is incapable of meeting the requirements of the claims.

Responsive to a pre-appeal brief review request, the Examiner reopened prosecution to

attempt to retrench from that which he had conceded by stating in the Final Rejection of 11/14/08, at page 3:

"the statement that the applicant that the examiner 'concedes' is no longer a valid argument, and the examiner has put forth that the drainage holes (25c) of the Kawamoto '690 piece are capable of allowing roots by way of the drainage holes to find their way to and thus knit essentially unimpeded into the earth below...."

This statement reflects Examiner imagination rather than a teaching by an anticipatory reference. More so, the Examiner's attempt to retrench overlooks the fact that the Kawamoto containers are located on a rooftop and balcony of a building or inside lot, and thus the Examiner's retrenching would have to have the roots making it through drainage holes and out of the on a rooftop and balcony of a building or inside lot; all of this and still be in accordance with the design so as to meet Applicant's claim requirements. The Examiner's retrenching would also have the roots do so without plugging the holes (so as to contradict the very purpose of *drainage* holes) or plug the drainage holes such that trapped moisture would kill the plant(s), while the roots are protruding off the rooftop or balcony or lot, so as to be essentially unimpeded. Yet further, Kawamoto mentions that "soil" is part of the problem to be solved by his invention and instead uses "artificial resin", which again contradicts Applicant's claimed roots can knit essentially unimpeded... into the earth below. More so, Kawamoto places underneath his containers "a water-penetrating type of sheet" further impeding the roots finding their way into the earth below. Yet further, the Examiner adds a bit of local color to what is alleged to be an anticipatory reference:

"It is well known to most everyone ever exposed to a plant in a container having drainage holes, roots do find their way to and through said holes and where the container is on the ground, those escaped roots grow into the ground below the container."

(Final Rejection of 11/14/08 at Page 7) The Examiner's addition also shows insufficiency of

Kawamoto as an anticipatory reference. The addition also is premised upon the Examiner's assumption that there is ground proximately below the container of Kawamoto. Actually, Kawamoto teaches to the contrary.

With all due respect, the Examiner's attempted retrenching is rather far fetched, and in a nutshell, Kawamoto does not meet the requirements of an anticipatory reference. There is no teaching in Kawamoto of installing the piece, so that the roots can knit essentially unimpeded from the piece into the earth below the piece at the user's location, in accordance with the design as per Groups I and II, and no teaching in Kawamoto of installing the mats at the user's garden location so that the roots are able to knit essentially unimpeded from the mats into earth below the mats to form the garden, according to the design as per Groups III and IV.

Applicant contends that there can be no anticipation where the cited art is "incapable" of meeting all claim limitations. The Examiner's conceding of "incapable" is as truthful today as it was when the Examiner first said so.

Other claim elements are not shown in Kawamoto too, as discussed below.

As to claim 21 (Group V.), the cited art also does not mention transporting the corporate logo to a garden site or ...installing the corporate logo at the garden site.... Indeed, there is no mention whatsoever in Kawamoto of a corporate logo. Examiner contends that this claim limitation is readable on Kawamoto's garden (Final Rejection of 11/14/08, page 9). Applicant contends that the question is not whether an Examiner can read the cited art in one way or another, but instead is whether Kawamoto discloses Applicant's ...installing the corporate logo at the garden site.... so as to meet the requirements of Sec. 102 for anticipation. The answer is that the reference does not mention the claim requirement, and thus there is no statutory anticipation. In sum, there is no statutory anticipation of any claim based on Kawamoto

because, as to each and every claim, there is at least one claim element required but not shown in Kawamoto.

Please now consider more particular arguments directed to each of the Groups.

1. Legal Standard

Anticipation is an exacting standard. Under 35 U.S.C. Sec. 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim. In re Bond, 910 F.2d, 832, 832, 15 USPQ2D 1566, 1567 (Fed. Cir. 1990). Implicitly in a review of an Examiner's anticipation analysis is that the claim must first have been correctly construed to divine the scope and meaning of each contested limitation. See, e.g., In re Paulson, 30 F.3d 1475, 1479, 31 USPQ2D 1671, 1674 (Fed. Cir. 1994)

It is respectfully submitted that, if the claims are properly construed, it will readily be seen that: "the manufactured multiple standardized units of Kawamoto are incapable of knitting with the earth below due to their containment means" as the Examiner truthfully conceded in the first Final Rejection; that statutory anticipation has not been evidenced based on because the cited art is "incapable" of meeting the respective claim limitations; and that Kawamoto has nothing to do with ...installing the corporate logo

2. Claim Construction

In construing claims, "as an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." In re Morris, 127 F.2d 1048, 1054, 44 USPQ2D 1023, 1027 (Fed. Cir. 1997).

Claim 1 requires ...installing the piece, so that the roots can knit essentially unimpeded from the piece into the earth below the piece at the user's garden location, in accordance with the design.

Claim 2 requires ...installing the mats at the user's garden location so that the roots are able to knit essentially unimpeded from the mats into the earth below the mats to form the garden, according to the design.

These are illustrated in Applicant's Figure 4 in view of Figure 5.

Claim 21 requires ... transporting the corporate logo to a garden site... and ...installing the corporate logo at the garden site....

This is illustrated in Figure 6, especially the originally-filed Figure 6, as shown in the Appendix hereto.

The Board's attention is respectfully drawn to the discussion of these figures for an initial perspective "enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." In re Morris, Id.

3. Cited Art: Kawamoto

The Board's attention is respectfully drawn to the figures of Kawamoto for an initial perspective. Note too that Kawamoto states that

"the purpose of this invention... is to offer a garden creating method that can easily create a garden with an overall uniformity and a beautiful view on a rooftop and balcony of a building or inside lot."

(translation at page 3, Para. [0004]. Kawamoto identifies "soil" as part of the problem to be solved by his invention (translation, page 4, line 9) and instead uses "artificial resin" (translation page 5, lines 11-12). See also, translation at page 5, line 22-24.

In the translation at Para. [0005] Kawamoto teaches "A garden creating method with the

characteristic that a water-penetrating type of sheet is first spread in a location where a garden should be created, and multiple standardized garden items are successively arranged side by side over said water-penetrating type of sheet."

In the translation at Para. [0008] Kawamoto states:

(4) Type illustrated in Figure 17 and 18, in the artificial soil (2b) is filtered inside of a frame part (2a) that forms the shape of a rectangular box, and lawn (2c) is planted over this artificial soil. Stainless steel can be satisfactorily used as the material of the aforementioned frame part (2a), however another metal, resin, china and porcelain, and ceramics, for example can be used besides stainless steel.

In the translation at Para. [0006] Kawamoto states:

"there is a type... that is vertically and horizontally approximately 400 mm long and approximately 120mm high. However, the size and the shape of said garden items are not limited only to these, and any in the size and shape that workers can carry around can be used."

Drainage holes 25c are mentioned with respect to the particular embodiment at page 1, Para. [0047]. With respect to claim 21, Kawamoto refers to a "garden" in his claim 1, and "lawn" in Para. [0007], "moss fungus" at Para. [0008], and, with respect to the size and shape of the garden items, "any shape that workers can carry around can be used. Para. [0006] Kawamoto states: "the purpose of this invention... is to offer a garden creating method that can easily create a garden with an overall uniformity" Para. [0004].

B. Separate Arguments for Each Claim Grouping Re Sec. 102 Rejections

1. Group I: Kawamoto Does Not Anticipate Claims 1, 18-20

Independent claim 1 and certain of its dependents 18-20 are grouped together. Claim 1 and all of its dependents require ... installing the piece, so that the roots can knit essentially unimpeded from the piece into earth below the piece at the user's garden location, in accordance with the design.

First, this claim element is not shown in Kawamoto, and thus there is no anticipation.

As stated above, at page 6 of the Office Action of 03/08/07, the Examiner concedes that "the manufactured multiple standardized units of Kawamoto are incapable of knitting with the earth below due to their containment means." There can be no anticipation because the cited art is incapable of meeting the claim limitation.

Applicant maintains that Kawamoto does not teach all claim elements, and thus statutory anticipation has not been shown. More particularly, Applicant maintains the contentions set forth in the pre-appeal brief review request, e.g., the Examiner concedes that "the manufactured multiple standardized units of Kawamoto are incapable of knitting with the earth below due to their containment means", remains as truthful today as it was when the Examiner conceded it.

Not only would Kawamoto's containment means be incapable, Kawamoto is directed to "a garden on a rooftop and balcony of a building and inside a lot" (translation at page 3, line 32), such that some structure would impede roots from knitting essentially unimpeded from the piece into the earth below the piece The same is true for the "water-penetrating sheet", and "artificial resin" (translation page 5, lines 11-12) would also impede roots from knitting essentially unimpeded from the piece into the earth below the piece

The Examiner theorizes in the Final Rejection, at page 3:

"the statement that the applicant that the examiner 'concedes' is no longer a valid argument, and the examiner has put forth that the drainage holes (25c) of the Kawamoto '690 piece are capable of allowing roots by way of the drainage holes to find their way to and thus knit essentially unimpeded into the earth below...."

This is an Examiner yarn rather than an anticipatory teaching of Kawamoto. Kawamoto is inadequate as an anticipatory reference. The Board's attention is

respectfully drawn back to the above-provided Overview of this Appeal Brief (which is incorporated by reference here for succinctness purposes).

Second, Kawamoto fails to disclose the Applicant's claimed earth below the piece, and instead identifies Kawamoto "soil" as part of the problem to be solved by his invention (translation, page 4, line 9). Kawamoto instead uses "artificial resin" (translation page 5, lines 11-12). See also, translation at page 5, line 22-24.

In the Office Action, at page 7, top paragraph, the Examiner points to Kawamoto (translation paras. 0008 and 0032) as Kawamoto teaching soil, but this mischaracterizes Kawamoto, which instead teaches "artificial soil." The "artificial soil" would itself impede roots from knitting essentially unimpeded with the earth below the piece.

Third, the same is true for the "water-penetrating type of sheet" further impeding the roots finding their way into the earth below the piece despite the Examiner's addition of local color to Kawamoto with what is contended to be "well known to most everyone ever exposed to a plant in a container having drainage holes." Final Rejection at Page 7.

Fourth, Applicant claims steps that must be considered as a whole. Claim 1 requires: ...forming a piece corresponding to a portion of the design... by growing roots in the piece at least one grower location;

transporting the piece to a user's garden location; and

installing the piece, so that...

The Examiner contends that this combination is disclosed in the statement of Kawamoto at Para. [0006] that "the size and the shape of said garden items are not limited only to these, and any in the size and shape that workers can carry around can be used." But the size and shape of Kawamoto's garden items do not teach the

combination.

One cannot determine, from Kawamoto, where his piece was formed (i.e., a grower location) or whether Kawamoto involved transporting the piece to a user's garden location (e.g., size and shape do not indicate actual transporting and even if they did, there is no indication where they are being transported from or what is being transported. Kawamoto does not disclose the claimed combination.

In sum, there is no anticipation because the cited art fails to disclose a least one claimed limitation. Further, cited art incapable of meeting a claim limitation cannot be an anticipation, as conceded by the Examiner, despite his implausible attempt at retrenching. Examiner hypothesizing cannot supplant deficient evidence, and more so, the hypothesizations are explicitly contradicted by Kawamoto's teachings. The evidence of Kawamoto is insufficient for a Sec. 102 rejection.

With the omission of a claim element in a reference, a prima facie rejection under Sec. 102 is defective. Kawamoto is not an anticipatory reference of claim 1, and thus is not an anticipatory reference of any of the dependent claims, particularly the claims of Group I: 1, 18-20.

2. Group II: Kawamoto Does Not Anticipate Claim 17

Claim 17 is dependent on claim 1. Thus, the arguments above regarding Group I are applicable to Group II, and if the Board determines that the rejection of Group I is in error, then it follows that the rejection of dependent claim 17 is in error. The arguments with respect to Group I are incorporated here by reference.

Claim 17 has been rejected under 102(a) based on Kawamoto (referenced herein to its translation). Claim 17 states wherein the forming the design includes forming a design of a

corporate logo. The cited art of Kawamoto says nothing about a corporate logo. Thus, Kawamoto is insufficient to meet the requirements of an anticipatory reference.

The Examiner argues (Final Rejection of 11/14/08 at page 9) that "the garden of Kawamoto encompasses and contemplates a corporate logo garden...." The Examiner also argues (page 9 of the Final Rejection of 11/14/08) that applicant's specification states that "it is an additional object to provide a system for commercially producing a landscape or garden design, such as a corporate logo" and thus, "Kawamoto anticipates or contemplates a corporate logo garden as claimed, as that form of design is readable on a garden with an overall uniformity and a beautiful view as taught by Kawamoto" (page 9). The Examiner further argues that "rearranging or planning a specific pattern or design such as a logo as broadly claimed is within the scope of the utility and capability of the Kawamoto system" (page 9).

However, applicant's "object" does not define a design or garden as synonymous with corporate logo, nor does Applicant's object make Kawamoto an anticipatory disclosure of a corporate logo. Further, it is well established law that a broad disclosure of a genus (the garden of Kawamoto, as suggested by the Examiner) does not render any species (corporate logo, as suggested by the Examiner) that falls within it obvious, let alone anticipated. See, e.g., in In re Baird, 16 F.3d 380 (Fed. Cir. 1994), in which the Federal Circuit held that a species claim is not necessarily obvious in light of a prior disclosure of a genus – and again, the instant rejection is based on *anticipation*. Thus, the Examiner's reasoning reflects an error of law. There is no teaching or suggestion in Kawamoto to lead the ordinary artisan to select the claimed specie (wherein the forming the design includes forming a design of a corporate logo).

The Examiner contentions at the bottom of page 9 of the Final Rejection of 11/14/08 are unavailing. What is readable by the Examiner is not the same as evidence of statutory

anticipation. Further, notice can be taken of the plain and ordinary meaning of the term logo, e.g., Webster's Unabridged Dictionary, which defines a logo as "a graphic representation or symbol of a company name, trademark, abbreviation, etc., often uniquely designed for ready recognition." See also the original Fig. 6 (Appendix) in parent application US Patent No. 6,336,291, consistent with this definition. The Examiner's argument is contradicted by the plain and ordinary meaning of the term logo and the parent's filing, and gives no weight to the preceding word, i.e., corporate logo. See the translation [Para. 0053] where a garden of "overall uniformity" contradicts forming a corporate logo. As to Kawamoto's "a garden on a rooftop and balcony of a building and inside a lot" (translation page 3, line 32), the rejection has offered no reason as to why one would be installing... a corporate logo on a "rooftop and balcony of a building and inside a lot" where it is not publicly viewable.

In sum, regarding the Sec. 102(a) rejection of claim 17, Kawamoto says nothing about a corporate logo. The only mention of corporate logo comes from the Applicant. There is no anticipation because Kawamoto fails to disclose at least one claim limitation, and thus the rejection is in error.

3. Group III: Kawamoto Does Not Anticipate Claims 2-15

Independent claim 2 and certain of its dependents 3-15 are grouped together. Claim 2 and its dependents 3-15 require ...installing the mats at the user's garden location so that the roots are able to knit essentially unimpeded from the mats into the earth below the mats to form the garden, according to the design.

First, this claim element is not shown in Kawamoto, and thus there is no anticipation.

As stated above with respect to the Sec. 102 rejection of claim 1 and certain of its dependents, at page 6 of the Office Action of 03/08/07, the Examiner concedes that "the

manufactured multiple standardized units of Kawamoto are incapable of knitting with the earth below due to their containment means.” There can be no anticipation because the cited art is incapable of meeting the claim limitation.

Applicant maintains that Kawamoto does not teach all claim elements, and thus statutory anticipation has not been shown. More particularly, Applicant maintains the contentions set forth in the pre-appeal brief review request, e.g., the Examiners concedes that “the manufactured multiple standardized units of Kawamoto are incapable of knitting with the earth below due to their containment means”, which remains as truthful today as it was when the Examiner said it.

There can be no anticipation where the cited art is incapable of meeting claim limitations, and the Examiner has not made out a case of prima facie anticipation for these claims.

Not only would Kawamoto's containment means be incapable, Kawamoto is directed to “a garden on a rooftop and balcony of a building and inside a lot” (translation at page 3, line 32), such that some structure would impede roots from knitting essentially unimpeded from the mats into the earth below the mats into the earth below the mats to form a garden according to the design. The same is true for the “water-penetrating sheet”, and “artificial resin” (translation page 5, lines 11-12) would also impede roots from knitting essentially unimpeded from the mats into the earth below the mats... according to the design

The Examiner theorizes in the Final Rejection of 11/14/08, at page 3:

“the statement that the applicant that the examiner ‘concedes’ is no longer a valid argument, and the examiner has put forth that the drainage holes (25c) of the Kawamoto ‘690 piece are capable of allowing roots by way of the drainage holes to find their way to and thus knit essentially unimpeded into the earth below....”

This is an Examiner yarn rather than a teaching of Kawamoto. Kawamoto is inadequate as an anticipatory reference. (The Board's attention is respectfully drawn back to the above-provided Overview of this Appeal Brief, incorporated here by reference with the caveat that claim 1 and claim 2 have distinct limitations.)

Second, Kawamoto fails to disclose the Applicant's claimed earth below the mats, and instead identifies Kawamoto "soil" as part of the problem to be solved by his invention (translation, page 4, line 9). Kawamoto instead uses "artificial resin" (translation page 5, lines 11-12). See also, translation at page 5, line 22-24.

In the Office Action, at page 7, top paragraph, the Examiner points to Kawamoto (translation paras. 0008 and 0032) as Kawamoto teaching soil, but this mischaracterizes Kawamoto, which instead teaches "artificial soil." The "artificial soil" would itself impede roots from knitting essentially unimpeded with the earth below the mats...

Third, the same is true for the "water-penetrating type of sheet" further impeding the roots finding their way into the earth below the mats... despite the Examiner's addition of local color to Kawamoto with what is contended to be "well known to most everyone ever exposed to a plant in a container having drainage holes." Final Rejection at Page 7.

Fourth, Kawamoto fails to disclose harvesting the mats in accordance with the claim as a whole. The Final Rejection of 11/14/08 makes no contention as to this claim element, presumably because it is not disclosed in the cited reference.

Fifth, Applicant claims steps that must be considered as a whole. Claim 1 requires: ...forming pieces corresponding to portions of the design by mats of roots of respectively different plants... at least one grower location:
harvesting the mats;

transporting the mats to a user's garden location; and
installing the mats so that...

The Examiner contends that this combination is disclosed in the statement of Kawamoto at Para. [0006] that "the size and the shape of said garden items are not limited only to these, and any in the size and shape that workers can carry around can be used." But the size and shape of Kawamoto's garden items do not teach the combination.

One cannot determine, from Kawamoto, where his "mats" were formed (i.e., a grower location) or whether Kawamoto involved harvesting or whether Kawamoto involved transporting the mats to a user's garden location (e.g., size and shape do not indicate actual transporting and even if they did, there is no indication where they are being transported from) or what was transported. There is no mention in Kawamoto of harvesting the mats, and Kawamoto does not disclose the claimed combination.

In sum, there is no anticipation because Kawamoto fails to disclose a least one the claimed limitation. Cited art incapable of meeting a claim limitation cannot be an anticipation, as conceded by the Examiner, despite his implausible attempt at retrenching. Examiner hypothecating cannot supplant deficient evidence, and more so, the hypothecations are explicitly contradicted by Kawamoto's teachings. The evidence is insufficient for a Sec. 102 rejection.

The omission of a claim element in a reference renders a prima facie rejection under Sec. 102 defective. Kawamoto is not an anticipatory reference of claim 2, and thus is not an anticipatory reference of the dependent claims 3-15.

4. Group IV: Kawamoto Does Not Anticipate Claim 16

Claim 16 is dependent on claim 2. Thus, the arguments above regarding Group III are applicable to Group IV, incorporated here by reference as if fully stated here, and if the Board determines that the rejection of Group III is in error, then it follows that the rejection of dependent claim 16 is in error.

Claim has been rejected under 102(a) based on Kawamoto (referenced herein to its translation). Claim 16 states wherein the forming the design includes forming a design of a corporate logo. The cited art of Kawamoto says nothing about a corporate logo. Thus, Kawamoto is insufficient to meet the requirements of an anticipatory reference.

The Examiner argues (Final Rejection of 11/14/08 at page 9) that "the garden of Kawamoto encompasses and contemplates a corporate logo garden...." The Examiner also argues (page 9 of the Final Rejection of 11/14/08) that applicant's specification states that "it is an additional object to provide a system for commercially producing a landscape or garden design, such as a corporate logo" and thus, "Kawamoto anticipates or contemplates a corporate logo garden as claimed, as that form of design is readable on a garden with an overall uniformity and a beautiful view as taught by Kawamoto" (page 9). The Examiner further argues that "rearranging or planning a specific pattern or design such as a logo as broadly claimed is within the scope of the utility and capability of the Kawamoto system" (page 9).

However, Applicant's "object" does not define a design or garden as synonymous with corporate logo as claimed, nor does Applicant's object make Kawamoto an anticipatory disclosure of a corporate logo. Further, it is well established law that a broad disclosure of a genus (the garden of Kawamoto, as suggested by the Examiner) does not render any species (corporate logo) that falls within it obvious, let alone anticipated. See, e.g., in In re Baird, 16 F.3d 380 (Fed. Cir. 1994), in which the Federal Circuit held that a species claim is not

necessarily obvious in light of a prior disclosure of a genus – and again, the instant rejection is based on *anticipation*. Thus, the Examiner's reasoning reflects an error of law. There is no teaching or suggestion in Kawamoto to lead the ordinary artisan to select the claimed specie (wherein the forming the design includes forming a design of a corporate logo).

The Examiner contentions at the bottom of page 9 of the Final Rejection of 11/14/08 are unavailing. What is readable by the Examiner is not the same as sufficient evidence of statutory anticipation, and notice can be taken of the plain and ordinary meaning of the term logo, e.g., Webster's Unabridged Dictionary, which defines a logo as "a graphic representation or symbol of a company name, trademark, abbreviation, etc., often uniquely designed for ready recognition." See also the original Fig. 6 (Appendix) in parent application US Patent No. 6,336,291, consistent with this definition. The Examiner's argument is contradicted by the plain and ordinary meaning of the term logo and the parent's filing, and gives no weight to the preceding word, i.e., corporate logo. See the translation [Para. 0053] where a garden of "overall uniformity" contradicts forming a corporate logo. As to Kawamoto's "a garden on a rooftop and balcony of a building and inside a lot" (translation page 3, line 32), the rejection has offered no reason as to why one would be installing... a corporate logo on a "rooftop and balcony of a building and inside a lot" where it is not publicly viewable.

In sum, regarding the Sec. 102(a) rejection of claim 16, Kawamoto says nothing about a corporate logo. The **only** mention of corporate logo comes from the Applicant. There is no anticipation because Kawamoto fails to disclose at least one claim limitation, and the rejection is in error.

5. Group V: Kawamoto Does Not Anticipate Claim 21

Claim 21 has been rejected under 102(a) based on Kawamoto (referenced herein to its

translation). Every step in the claim requires a corporate logo, e.g., transporting the corporate logo to a garden site, etc. The cited art of Kawamoto says nothing about a corporate logo.

With regard to the Sec. 102 rejection, in the Final Rejection of 11/14/08 at page 9, the Examiner points to the rejection of claims 1, 2, 16, and 17. But Kawamoto does not mention transporting the corporate logo to a garden site, and nothing in Kawamoto even mentions a corporate logo. Thus, the evidence is not sufficient for statutory anticipation.

The Examiner argues (Final Rejection of 11/14/08 at page 9) that "the garden of Kawamoto encompasses and contemplates a corporate logo garden..." The Examiner also argues (page 9 of the Final Rejection of 11/14/08) that applicant's specification states that "it is an additional object to provide a system for commercially producing a landscape or garden design, such as a corporate logo" and thus, "Kawamoto anticipates or contemplates a corporate logo garden as claimed, as that form of design is readable on a garden with an overall uniformity and a beautiful view as taught by Kawamoto" (page 9). The Examiner further argues that "rearranging or planning a specific pattern or design such as a logo as broadly claimed is within the scope of the utility and capability of the Kawamoto system" (page 9).

However, applicant's "object" does not define a design or garden as synonymous with corporate logo, nor does Applicant's object make Kawamoto an anticipatory disclosure of a corporate logo. Further, it is well established law that a broad disclosure of a genus (the design of Kawamoto, as suggested by the Examiner) does not render any species (corporate logo, as suggested by the Examiner) that falls within it obvious, let alone anticipated. See, e.g., in In re Baird, 16 F.3d 380 (Fed. Cir. 1994), in which the Federal Circuit held that a species claim is not necessarily obvious in light of a prior disclosure of a genus. In the present case, the rejection is based on *anticipation*, and so the Examiner's reasoning is an error of law. There is no teaching

or suggestion in Kawamoto to lead the ordinary artisan to select the claimed specie
(transporting the corporate logo to a garden site).

The Examiner contentions at the bottom of page 9 of the Final Rejection of 11/14/08 are unavailing. What is readable by the Examiner is not the same as sufficient evidence of statutory anticipation, and notice can be taken of the plain and ordinary meaning of the term logo, e.g., Webster's Unabridged Dictionary, which defines a logo as "a graphic representation or symbol of a company name, trademark, abbreviation, etc., often uniquely designed for ready recognition." See also the original Fig. 6 (Appendix) in parent application US Patent No. 6,336,291, consistent with this definition. The Examiner's argument is contradicted by the plain and ordinary meaning of the term logo and the parent's filing, and gives no weight to the preceding word, i.e., corporate logo. See the translation [Para. 0053] where a garden of "overall uniformity" contradicts or teaches away from forming a corporate logo. As to Kawamoto's "a garden on a rooftop and balcony of a building and inside a lot" (translation page 3, line 32), and the rejection has offered no reason as to why one would be transporting the corporate logo to a "rooftop and balcony of a building and inside a lot" where it is not publicly viewable.

In sum, regarding the Sec. 102(a) rejection, every step in the claim requires a corporate logo, e.g., transporting the corporate logo to a garden site, etc. Kawamoto says nothing about a corporate logo. The **only** mention of corporate logo, e.g., the claim step of transporting the corporate logo to a garden site, etc, comes from the Applicant. There is no anticipation because the cited art fails to disclose any of the claimed steps because there is no mention in Kawamoto of a corporate logo. This omission of one or more essential element needed for a prima facie rejection is a clear error in the rejection.

6. Group VI: Kawamoto Does Not Anticipate Claim 22

The argument with respect to the independent claim 1 is incorporated by reference here. Further, there is no teaching in Kawamoto of the biodegradable matrix within the piece.

7. Group VII: Kawamoto Does Not Anticipate Claim 23

The argument with respect to the independent claim 1 is incorporated by reference here. Further, there is no teaching in Kawamoto of the biodegradable matrix within the piece.

8. Group VIII: Kawamoto Does Not Anticipate Claim 24

The argument with respect to the independent claim 1 is incorporated by reference here. Further, there is no teaching in Kawamoto of the growing the corporate logo in a biodegradable matrix.

9. Summary re Sec. 102

With respect to claims of each Group, at least one claim element is not shown in Kawamoto. Thus, for the reasons more fully set out above, the claims have not been properly shown as anticipated under Sec. 102, and the rejections should be reversed.

C. Separate Arguments for Each Claim Re Sec. 103 Rejections

1. The Examiner has not made a prima facie showing that claim 1 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 1 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of ***factually supporting*** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***"

[emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, “[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**” [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that “rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” In *re Kahn*, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International, Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner’s rejection is that it ignores the fact that the “no change in their respective functions” is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with **no change in their respective functions**, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*,

425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

2. The Examiner has not made a prima facie showing that claim 2 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 2 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of

unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**" [emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**" [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International*, *Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence,

the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.

- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

3. The Examiner has not made a prima facie showing that claim 3 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 3 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be

useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*. Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**" [emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**" [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR International, *Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention

of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

4. The Examiner has not made a prima facie showing that claim 4 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 4 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of ***factually supporting*** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***"

[emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, “[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**” [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that “rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” In *re Kahn*, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International, Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner’s rejection is that it ignores the fact that the “no change in their respective functions” is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with **no change in their respective functions**, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*,

425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

5. The Examiner has not made a prima facie showing that claim 5 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 5 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2D 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states “[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**” [emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, “[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**” [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that “rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International*, *Id*.

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of

obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.

- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

6. The Examiner has not made a prima facie showing that claim 6 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 6 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of*

continuing prosecution...". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**" [*emphasis added*] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**" [*emphasis added*] The

Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR International, *Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

7. The Examiner has not made a prima facie showing that claim 72 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 7 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at

page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of

nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***"

[emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the ***analysis supporting*** a rejection under 35 U.S.C. Sec. 103 ***should be explicit.***" [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR International, *Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the

elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

8. The Examiner has not made a prima facie showing that claim 8 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 8 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The

Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states “[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**” [emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, “[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**” [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that “rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International, Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options,

without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.

- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

9. The Examiner has not made a prima facie showing that claim 9 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 9 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of*

continuing prosecution...". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**" [emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**" [emphasis added] The

Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR International, *Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

10. The Examiner has not made a prima facie showing that claim 10 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 10 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at

page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of

nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***"

[emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the ***analysis supporting*** a rejection under 35 U.S.C. Sec. 103 ***should be explicit.***" [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In *re Kahn*, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International, Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the

elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

11. The Examiner has not made a prima facie showing that claim 11 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 11 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The

Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states “[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**” [emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, “[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**” [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that “rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International, Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options,

without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.

- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

12. The Examiner has not made a prima facie showing that claim 12 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 12 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of*

continuing prosecution...". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**" [*emphasis added*] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**" [*emphasis added*] The

Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR International, *Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

13. The Examiner has not made a prima facie showing that claim 13 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 13 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at

page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of

nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***"

[emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the ***analysis supporting*** a rejection under 35 U.S.C. Sec. 103 ***should be explicit.***" [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR International, *Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the

elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

14. The Examiner has not made a prima facie showing that claim 14 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 14 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The

Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states “[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**” [emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, “[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**” [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that “rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International, Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options,

without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.

- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

15. The Examiner has not made a prima facie showing that claim 15 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 15 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of*

continuing prosecution...". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**" [*emphasis added*] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**" [*emphasis added*] The

Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR International, *Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

16. The Examiner has not made a prima facie showing that claim 16 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 16 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at

page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of

nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***"

[emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the ***analysis supporting*** a rejection under 35 U.S.C. Sec. 103 ***should be explicit.***" [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR International, *Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the

elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

17. The Examiner has not made a prima facie showing that claim 17 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 17 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The

Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states “[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**” [emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, “[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**” [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that “rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International, Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options,

without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.

- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

18. The Examiner has not made a prima facie showing that claim 18 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 18 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of*

continuing prosecution...". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**" [*emphasis added*] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**" [*emphasis added*] The

Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR International, *Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

19. The Examiner has not made a prima facie showing that claim 19 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 19 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at

page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2D 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of

nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***"

[emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the ***analysis supporting*** a rejection under 35 U.S.C. Sec. 103 ***should be explicit.***" [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In *re Kahn*, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International, Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the

elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

20. The Examiner has not made a prima facie showing that claim 20 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 20 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The

Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states “[t]he examiner bears the initial burden of ***factually supporting*** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***” [emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, “[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the ***analysis supporting*** a rejection under 35 U.S.C. Sec. 103 ***should be explicit.***” [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that “rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International, Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options,

without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.

- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

21. The Examiner has not made a prima facie showing that claim 21 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 21 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of*

continuing prosecution...". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**" [*emphasis added*] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**" [*emphasis added*] The

Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International, Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

22. The Examiner has not made a prima facie showing that claim 22 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 22 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at

page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*. Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of

nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***"

[emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the ***analysis supporting*** a rejection under 35 U.S.C. Sec. 103 ***should be explicit.***" [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR International, *Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the

elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

23. The Examiner has not made a prima facie showing that claim 23 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 23 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The

Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states “[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**” [emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, “[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**” [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that “rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International, Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options,

without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.

- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

24. The Examiner has not made a prima facie showing that claim 24 is unpatentable pursuant to 35 U.S.C. § 103 based on Kawamoto

Applicant incorporates by reference as if fully stated herein the argument regarding claim 24 above. There is at least one claim element that has not been shown in the cited art, and thus the rejection is in error.

The rejection based on Sec. 103 amounts to no more than an alternative expression at page 5 of the Final Rejection: "35 U.S.C. 102(a), as anticipated by or, in the alternative under 35 U.S.C. 103(a), as obvious over Kawamoto...." This is an improper rejection per se.

More particularly, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of*

continuing prosecution...". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner has the initial burden of proof in presenting a prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met by a mere alternative expression.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**" [*emphasis added*] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 U.S.C. Sec. 103 **should be explicit.**" [*emphasis added*] The

Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR International, *Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from MPEP Sec. 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed Previously presented invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's alternative mention of obviousness, the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Due to the absence of any substantive contention of obviousness, other than the alternative expression (i.e., "or in the alternative") the rejection is because the Examiner has not made out a case of prima facie obviousness for at least the following reasons:

- (1) At least one claim element is not disclosed in the cited art.
- (2) There is no reasonable expectation of success has been established for making the proposed modification or combination.
- (3) The art teaches away from the claimed invention.
- (4) No reason to combine or modify has been shown from the prior art.
- (5) The contended rejection, to reach the claimed invention, would change the principles of operation of the cited art.
- (6) The contended rejection, to reach the claimed invention, would render the cited art inoperable for its purpose.

In sum, the rejection is improper pursuant to Secs. 132 and 103, and Rule 104 and must be reversed.

25. Summary re Sec. 103

With respect to each claim rejected "in the alternative" under Sec. 103, at least one claim element is not shown in Kawamoto. Thus, for the reasons more fully set out above, have not been properly shown as anticipated under Sec. 103, and the rejection should be reversed.

VIII. Conclusion

With respect to claims of each Group, at least one claim element is not shown in Kawamoto.

Thus, for the reasons more fully set out above, have not been properly shown as anticipated under Sec. 102 or in the alternative obvious under Sec. 103, and the rejection should be reversed. Allowance is respectfully requested.

Respectfully submitted,



Date: January 8, 2010

Peter K. Trzyna
(Reg. No. 32,601)

P.O. Box 7131
Chicago, IL 60680-7131
(312) 240-0824

VIII. Claims Appendix

1. A method of forming a garden, the method including:

forming a design for a garden;

implementing the design by forming a piece corresponding to a portion of the design, the piece including at least one member of the group consisting of forbs, a shrub, a tree, annuals, flowering plants, a bush, wildflowers, grasses, a space for a shrub, a space for a tree, a space for annuals, a space for layers of flowering plants, a space for a bush, a space for wildflowers, a space for grasses, a space for a walkway, and a space for a garden accouterment, by growing roots in the piece at at least one grower location;

transporting the piece to a user's garden location; and

installing the piece, so that the roots can knit essentially unimpeded from the piece into earth below the piece at the user's garden location, in accordance with the design.

2. A method of forming a garden, the method including:

forming a design for a garden;

forming pieces corresponding to portions of the design by growing mats of roots of respectively different kinds of plants, in accordance with the design, at at least one grower location;

harvesting the mats;

transporting the mats to a user's garden location; and

installing the mats at the user's garden location so that the roots are able to knit essentially unimpeded from the mats into earth below the mats to form the garden, according to the design.

3. The method of claim 2, wherein the design is implemented with at least one of the pieces including at least one member of the group consisting of forbs, a shrub, a tree, annuals, flowering plants, a bush, wildflowers, grasses, a crop, a space for a shrub, a space for a tree, a space for annuals, a space for flowering plants, a space for a bush, a space for wildflowers, a space for grasses, a space for a walkway, and a space for a garden accouterment, in accordance with the design.

4. The method of claim 3, further including a second member of the group, in accordance with the design.

5. The method of claim 3, further including a third member of the group, in accordance with the design.

6. The method of claim 3, wherein the mats differ by at least one kind of plant that is a member of the group, in accordance with the design.

7. The method of claim 3, wherein the mats differ by at least two kinds of plants that are members of the group, in accordance with the design.

8. The method of claim 3, wherein the mats differ by at least three kinds of plants that are members of the group, in accordance with the design.

9. The method of claim 3, wherein the mats differ by at least four kinds of plants that are members of the group, in accordance with the design.

10. The method of claim 3, wherein the mats differ by at least five kinds of plants that are members of the group, in accordance with the design.

11. The method of claim 3, wherein the mats differ by at least six kinds of plants that are members of the group, in accordance with the design.

12. The method of claim 3, wherein the mats differ by at least seven kinds of plants that are members of the group, in accordance with the design.

13. The method of claim 3, wherein the mats differ by at least eight kinds of plants that are members of the group, in accordance with the design.

14. The method of claim 6, further including lawn on a portion of at least one of the mats.

15. The method of claim 7, further including lawn on a portion of at least one of the mats.

16. The method of claim 2, wherein the forming the design includes forming a design of a corporate logo.

17. The method of claim 1, wherein the forming the design includes forming a design of a corporate logo.

18. The method of claim 1, wherein the forming the piece is carried out so as to include a second member of the group, in accordance with the design.

19. The method of claim 1, wherein the forming the piece is carried out so as to include a third member of the group, in accordance with the design.

20. The method of claim 1, further including forming a second piece corresponding to a second portion of the design, the second piece differing from the first piece by at least one kind of plant that is a member of the group, in accordance with the design;
growing the second piece, in accordance with the design;
transporting the second piece to the user's garden location; and
installing the second piece at the user's garden location, in accordance with the design.

21. A method of forming a corporate logo garden, the method including:
forming a design for a garden comprised of a corporate logo;
growing the corporate logo, in accordance with the design, including at least one member of the group consisting of a forb, a shrub, a tree, an annual, a flowering plant, a bush, a wildflower, and grass, at a grower location;

transporting the corporate logo to a garden site; and

installing the corporate logo at the garden site to produce the garden having the corporate logo design.

22. The method of claim 1, wherein the forming comprises locating a biodegradable matrix within the piece.

23. The method of claim 2, wherein the growing comprises locating a biodegradable matrix within the piece.

24. The method of claim 3, wherein the growing comprises growing the corporate logo in a biodegradable matrix.

IX. **Evidence Appendix**

No evidence.

X. Related Proceedings Appendix

There are no related proceedings.